

Appl. No. 10/810,347  
Amdt. dated June 26, 2006  
Reply to Office action of 04/25/2006

### **REMARKS/ARGUMENTS**

Claims 1-17 are currently pending in which claims 1, 15 and 17 are in independent format. In this response, Claims 1-17 are being amended.

#### **I. Examiner Interview Summary**

The Applicant expresses his appreciation for the June 15, 2006 Examiner interview. In the interview, all the independent claims were discussed along with the *Huffman*, *Spivey* and *Dantalon* references. No allowable subject matter was agreed upon.

#### **II. Claim objections**

The objection with respect to the numbering of the claims is moot, as the claims have been amended for correct numbering.

#### **III. Rejection of Claims 1-17 Under 35 U.S.C. § 112**

The rejection of claims 1-17 is moot, as claims 1, 15 and 17 recite the device consists essentially of a normally non-rotatable weight positioned at the second end of the handle. A claim that depends from a claim that "consists of" the recited elements or steps cannot add an element or step. When the phrase "consists of" appears in a clause of the body of a claim, rather than immediately following the preamble, it limits only the element set forth in that clause; other elements are not excluded from the claim as a whole. M.P.E.P. § 2111.03 Transitional Phrases, (citing: *Mannesmann Demag*

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*Corp. v. Engineered Metal Products Co.*, 793 F.2d 1279, 230 USPQ 45 (Fed. Cir. 1986).

>See also *In re Crish*, 393 F.3d 1253, 73 USPQ2d 1364 (Fed. Cir. 2004).

**IV. Rejection of Claims 1-17 under 35 U.S.C. § 103(a)**

The rejection of Claims 1-17 under 35 U.S.C. § 103(a) as being allegedly unpatentable by U.S. Patent No. 6,228,002 (the "Dantolan" reference) in view of U.S. Patent No. 5,215,307 (the "Huffman reference") further in view of U.S. Patent No. 4,272077 (the "Spivey" reference) is respectfully traversed.

A *prima facie* case of obviousness is established when one or more references that were available to the inventor and teach that a suggestion to combine or modify the references, the combination or modification of which would appear to be sufficient to have made the claimed invention obvious to one of ordinary skill in the art.

Under M.P.E.P. § 706.02(j), three basic criteria must be met for the *prima facie* case of obviousness. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*,

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947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Additionally, prior art may be considered not to teach an invention and thereby may fail to support an obviousness rejection, particularly when the stated objectives of the prior art reinforce such an interpretation. *WMS Gaming Inc., v. International Game Tech.*, 184 F.3d 1339, 51 USPQ2d 1385 (Fed. Cir. 1999).

The *Dantolan* reference teaches a rotatable weight exercise device. In this reference, a rigid hollow tube has a rotatable weight on its lower end. (See: Column 2, lines 20-25, Figs. 1-3). During exercise, the user grasps the device with a hand and moves the device while rotating the wrist, which in turn will rotate the rotatable weight. In other words, during use, the rotatable weight will rotate in the same direction as the wrist. (See: Column 3, lines 4-10). The amended claims of the present application recite a normally non-rotatable weight. In other words, once the weight is attached to the second end of the handle, the weight is fixed, that is to say, the weight does not rotate about the handle when the user performs exercises with the device. The *Dantolan* reference does not teach or suggest this claim limitation. As such, a *prima facie* case of obviousness has not been achieved.

The *Spivey* reference teaches a golf putter that minimizes putter jerks by preventing the non-dominant hand from overriding the dominant hand. (See: Abstract). The *Spivey* reference teaches keeping the non-dominant hand in its most relaxed

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muscular condition. (See: Column 1, lines 28-30). This reference uses a formula determined by hand sizes that forces the grip of the non-dominant putting hand to be in a relaxed position so that it does not pull against the putting motion of the dominant hand. (See: Column 1, lines 31-34). As shown in Figs. 4 and 5, a measurement of the golfer's hand is taken to size the distance between the tip of the index finger and the metacarpo phalangeal joint. This measurement is used to determine the circumference of the golf putter grip. (See: Column 2, lines 55-68). By having the non-dominant hand around this sized grip, the non-dominant hand is in the as near as possible relaxed position. (See: Column 3, lines 25-30)(Emphasis added). During use, the dominant hand of the golfer grips the putter tightly while muscles in the non-dominant hand remain relaxed.

In contrast, the claimed features of the present application recite that positioning of the normally non-rotatable weight and the handle circumference direct the effect of the weight in a concentrated manner to the forearms of the user. In other words, both forearms of the user are flexed (i.e., non-relaxed as stated in the *Spivey* reference). The *Spivey* reference does not provide any suggestion or motivation to modify the reference or to combine reference teachings in order to obtain the claimed features of the present application. The stated objectives of the *Spivey* reference clearly do not provide an interpretation of the claimed features of the present application. (See:

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*WMS Gaming Inc.*, 184 F.3d 1339 (Fed. Cir. 1999). As such, a *prima facie* case of obviousness has not been achieved.

The *Huffman* reference teaches a training exercise method. The method provides a normal balance to the user while the user swings a counter weighted device. (See: Abstract)(Emphasis added). The device includes a shaft with weights at opposing ends that counter balance each other. In the background section, the *Huffman* reference discloses that a training device having a weight at only one end of a training device results in the disadvantage of pulling the user toward the weight. (See: Col. 1, lines 10-11). Applicant respectfully notes that the *Huffman* reference requires opposing and counter balancing weight. Amended Claims 1, 15 and 17 recite the device consists essentially of a weight. A claim that depends from a claim that "consists of" the recited elements or steps cannot add an element or step. When the phrase "consists of" appears in a clause of the body of a claim, rather than immediately following the preamble, it limits only the element set forth in that clause; other elements are not excluded from the claim as a whole. M.P.E.P. § 2111.03 Transitional Phrases, (*citing: Mannesmann Demag Corp. v. Engineered Metal Products Co.*, 793 F.2d 1279, 230 USPQ 45 (Fed. Cir. 1986). >See also *In re Crish*, 393 F.3d 1253, 73 USPQ2d 1364 (Fed. Cir. 2004)). Furthermore, the *Huffman* reference discloses that a need exists for an exercise method that does not affect the balance of the user while performing the

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exercise. (See: Col., lines 20-21). In fact, the *Huffman* reference states that the "key is the counter balanced weights at opposite ends of the shaft with one of the weights being between the hands on the grip and the user's body." (See: Col. 2, lines 54-57)(Emphasis added).

In contrast, the present application teaches that the positioning of the non-rotatable weight, the positioning of its center of mass and the sizing of the handle circumference are configured to direct the effect of the weight in a concentrated manner to the forearms of the user, as recited in amended Claims 1, 15 and 17. (See *Specification*: page 1, line 22, page 2, lines 8-9 and page 10, lines 22-26). In other words, the single weight of the present application results in an unbalanced force in order to direct the concentration of the effect of the weight to the user's forearm. Furthermore, in order to concentrate the effect of the weight to the user's forearm, the weight must be at the end of the shaft. As such, the weight of the present application is not positioned between the user's hand and the user's body as taught and emphasized by the *Huffman* reference.

Since the present application uses a single weight at the end of the shaft to provide an unbalanced weight, one skilled in the art would not be motivated to seek out the *Huffman* reference due to the required balanced weights and the stated objectives of the *Huffman* reference. Accordingly, the *Huffman* reference does not teach a

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suggestion or motivation to modify in order to achieve the present application. As such, a *prima facie* case of obviousness has not been achieved.

Additionally, the *Huffman* reference does not teach or suggest all of the present claim limitations such as the positioning of the center of mass and the sizing of the handle circumference. The claimed features of the present application direct the effect of the weight in a concentrated manner to the forearms of the user.

The reference-by-reference, limitation-by-limitation analysis by the Examiner has not provided a *prima facie* case of obviousness. The Applicant respectfully requests the Examiner to comment on the Applicant's DVD presentation that was provided in the previous response. As noted in the DVD illustrating a prototype video relating to the application, the experts repeatedly assert that speed and power come from the forearms (See *also*: video presentation which highlights forearm strength exercises). Furthermore, as shown in the video presentation, the claimed feature of the single weight positioned at the end of the end the second end allows the user to swing the device near the body of the user.

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner withdraw all presently outstanding rejections. It is believed that a full

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and complete response has been made to the outstanding Office Action, and as such, the present applicant is in condition for allowance.

Entrance of the amendment and passage of the case to issue are therefore respectfully requested. If the Examiner believes that personal communication will expedite prosecution of the application, the Examiner is invited to telephone the undersigned at (314) 238-2400.

Respectfully submitted,

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